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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,325	12/08/2003	Jerome Skuba	Skuba-P1-03	2418
28710 7590 11/14/2008 PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680				
EXAMINER				
PALO, FRANCIS T				
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3644				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/730,325

**Applicant(s)**

SKUBA, JEROME

**Examiner**

Francis T. Palo

**Art Unit**

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment / Arguments***

Applicant's arguments filed 3/11/08 have been fully considered but they are not persuasive.

*Applicant submits:*

*In the Office Action, at pages 2-3, claims 1-20 have been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that the claims fail to particularly point out and distinctly claim the invention.*

*Claims 1-2 have been amended, such that the rejection is believed to be moot. It is respectfully submitted that the Examiner has not made out a proper case of non-enablement. For example, Figure 3 illustrates the roots growing ...essentially unimpeded from the piece into earth below the piece., and ...essentially unimpeded from the mats into earth below the mats as claimed. And if the Examiner's concern is directed instead to the composition of the piece itself, note that the items referenced in the Office Action (in the middle paragraph of page 3) are disclosed in the specification as biodegradable, and thus would not impede the roots, either. The Examiner has not made out a case of prima facie non-enablement in view of Figure 3.*

The examiner responds:

Applicant is respectfully reminded that the specification cannot be relied upon to breathe meaning in to the claim(s); and in consideration of the response to the 35 U.S.C. 112 rejection, the examiner takes the position that any root(s) capable of finding their way through the drainage holes (25c) as depicted in figure-19 of Kawamoto '690, are therefore readable on the limitation, "so that the roots can knit **essentially** unimpeded from the piece into earth below the piece".

As the examiner has conveyed his position on the meaning of the limitation and made it clear as a matter of record, the 35 U.S.C. 112 rejection made in the office action mailed 12/12/07 is vacated.

*Applicant submits:*

*In the Office Action, at pages 4-9, claims 1-20 have been rejected pursuant to 35 U.S.C. Sec. 102. The Examiner contends that the claims are anticipated by Kawamoto.*

*In response Applicant maintains that the cited art does not teach all claim elements. More particularly, Applicant maintains the contentions set forth in the pre-appeal brief review request, e.g., the Examiners concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means".*

The examiner responds:

As a result of the pre-appeal conference the examiner restated his position and afforded the applicant yet another non-final office action, so the statement by applicant that the examiner "concedes" is no longer a valid argument, as the examiner has put forth that the drainage holes (25c) of the Kawamoto '690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below as broadly claimed.

*Applicant submits:*

*With respect to claim 21, Applicant maintains the view set out in the pre-appeal brief review request, to which the Examiner's attention is respectfully drawn. Because the Examiner has not shown that the garden in Kawamoto is the same as the claimed corporate logo, the Examiner has not made out a case of prima facie anticipation for this claim.*

*New claims 22-24 distinguish over the cited art for the same reasons, respectively, as set out above.*

The examiner responds:

In the rejection of claims 16 and 17 in the previous non-final office action, the examiner points out that the instant specification recites, "*it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo pattern*". As Kawamoto teaches modular landscape or garden design, the examiner maintains the position that a corporate logo pattern as broadly claimed is readable on the teaching of Kawamoto, as a corporate logo as claimed is considered to be encompassed by a modular landscape or garden design.

Concluding; applicant's comments have been given careful consideration and are deemed as unpersuasive, and as such, the claim rejections submitted in the non-final office action mailed 12/12/07 are maintained unchanged and are merely repeated herein this final office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-21** are rejected under 35 U.S.C. 102(a),  
as anticipated by or, in the alternative, under 35 U.S.C. 103(a),  
as obvious over **Kawamoto** (JP 10313690A) 1998;  
Priority Date (JP0127110) 5/1997.

Regarding **claim-1**:

As submitted in the previous office action, **Kawamoto '690** teaches a **garden creating method** of successively arranged multiple standardized garden items ('690 claim-1), which is read as **forming a design and implementing the design**, as claimed.

Kawamoto further depicts in the figures, **forming pieces** (figures 4, 5, 11-18 and 22) corresponding to a portion of the design (figures 3, 6, 7), as claimed; specifically, a grass piece (figure-5), plants (figure-22) and stone (figure-4) among others, are depicted as claimed.

Kawamoto also teaches [0045] **garden items** (21-24 and 30) are **formed, packaged and shipped** (as in transported to a user's garden location) and [0006] that the size and shape of the garden items are not limited to parallelepiped shape, and any in the size and shape that **workers can carry around** can be used.

**Note**; that a "piece" as broadly claimed, has been afforded the broadest possible interpretation, as reading on the "standardized garden items (containers)" as taught by Kawamoto, and that by the disclosure and figures of Kawamoto, a method of forming a garden by forming a design and implementing the design by forming a piece corresponding to a portion of the design by growing roots in the piece at, at least one grower location, is evident from the figures and/or are disclosed by Kawamoto.

As regards the amended language directed to the roots knitting essentially unimpeded with the earth below as claimed, and in consideration of the **35 USC § 112** rejection previously presented; Kawamoto teaches [0008] that as depicted in figures 17 and 18, frame (2a) is filled with soil (2b) and lawn (2c) is planted over this arrangement, and [0032] that roots of said lawn (2c) are strongly rooted in the soil.

In consideration of applicant's comments, the argument is well taken that since the "piece" of Kawamoto includes the containment means, as such, the roots are unable to knit essentially unimpeded with the earth below the piece.

The examiner responds that Kawamoto depicts in figure-19, containment means provided with irrigation holes (25c), and it is well known to most anyone ever exposed to a plant in a container having drainage holes, roots do find their way to and through said holes, and where the container is on the ground, those escaped roots grow into the ground below the container.

Therefore, it is respectfully submitted that Kawamoto is capable of the amended claim language, as best can be understood, as the roots of the plant material growing in the container of Kawamoto are capable of finding their way to and through the drainage holes (25c) depicted in figure-19 to root, "essentially unimpeded" with earth below the piece, which comprises the container, growth medium and plant(s) growing therein, as claimed.

Regarding independent **claim-2**:

The discussion above regarding claim-1 is relied upon.

The instant claim differs from claim-1 in that applicant is now claiming a "**mat**" of roots instead of a "**piece**" as recited in claim-1.

The examiner respectfully submits that the rejection above as regards the "piece" is applicable to the "mat" as now claimed; as Kawamoto teaches as depicted in his figures a sod mat (not seed) placed on top of the soil within the container, and as the container is provided with drainage holes, the roots from the mat would eventually find their way to and through the drainage holes, which would be readable thereon the amended claim language.



Regarding **claim-3**:

The discussion above regarding claim-2 is relied upon.

Kawamoto teaches "lawn" (grasses as claimed) among others, as discussed above in the independent claims.

Regarding **claims 4 and 5**:

The discussion above regarding claim-3 is relied upon.

Second and third members as claimed, are readily apparent from the figures of Kawamoto; specifically in figures 3, 6, 7, and as discussed above in claim-1.

Regarding **claims 6-15, 18 and 19**:

The discussions above regarding claims 1 and 3 are relied upon.

Kawamoto teaches lawn [0007], moss [0008] and that the garden items should not be limited to only those items that are listed [0007]; as there are many species of grasses (both ornamental and lawn species) and likewise moss, Kawamoto thus encompasses the eight mat members as claimed in the instant claims.

Regarding **claim-20**:

The discussions above regarding claims 1 and 2 are relied upon as encompassing the limitations of the instant claim.

Regarding repeating **claims 16 and 17**:

The discussions above regarding claims 1 and 2 are relied upon.

Kawamoto teaches in his system that a **garden with an overall uniformity** and a beautiful view can be created in a location where the garden should be created, including the rooftop and balcony of a building **or within a lot** (USPTO translation; [0053]).

It is respectfully submitted that the garden of Kawamoto encompasses and contemplates a corporate logo garden as claimed, as in turning to the instant disclosure for guidance on the meaning of a corporate logo, it is noted on page-8 of the instant specification that applicant recites, "it is an additional object to provide a system for commercially producing a landscape or **garden design, such as a corporate logo pattern**".

It is respectfully maintained that Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of garden design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto and as claimed, and that rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system.

Regarding independent **claim-21**:

The revised discussions above regarding claims 1, 2, 16 and 17 are relied upon as teaching the limitations of the new independent claim.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on 571-272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Francis T. Palo/  
Primary Examiner  
Art Unit 3644